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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/760,094	01/17/2004	Richard R. Mullarkey	RM-1-gw	2134
7590	10/04/2004			
EXAMINER				
LEGESSE, NINI F				
ART UNIT			PAPER NUMBER	
3711				

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/760,094

Applicant(s)

MULLARKEY, RICHARD R.

Examiner

Nini F. Legesse

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The drawings are objected to because the side view of the invention as shown on Fig. 5 does not match the other figures. In this figure, it is not clear how one can maintain a hinge function when the clip is made of just one-piece element wherein the jaws do not extend through the pivot point of the clip. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. At various sections of the specification it is indicated that hinge 24 have an adjustment knob 32 for angular adjustment (for example see lines 14-15 on page 21 of the specification). However, there is insufficient structure disclosed for the structure of the "angular adjustment member" that would allow one to make and use the invention without undue experimentation. What are the components of the "angular adjustment member" that would allow the adjustment of the lighting element?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how the device provides an angular adjustment with the structural arrangement as shown in the figures. It is not clear from

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the specification how one maintains a hinge element that is capable of an angular adjustment. How is the angle adjusted? What makes the clip to open and close? What is the structure of the angular adjustment member that would allow the light element to be adjusted?

**As best understood the claims are rejected as follow.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1- 4** are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (US Patent No. 6,467,929).

**With respect to claims 1 - 3**, Lee discloses an apparatus comprising:

- A housing that is adapted for attachment to the brim of a hat (see Figs. 15-16, the housing is the shell that contains item 14);
- A light source (14);
- An angular adjustment member (150);
- A clip (48); and
- Wherein the angular adjustment member comprises a hinge (38).

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With respect to the recitation that the device is to be used as a training aid for a golfer and the light to be directed toward a golf ball, as stated in claim 1, it is noted that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Thus, since the device of Lee is capable of being used as a training aid for a golfer, the device clearly meets all the limitations of the above claims.

**With respect to claim 4**, Lee discloses an adjusting knob being disposed on the hinge to adjust the angle of the hinge. In order to determine whether application claims must be found unpatentable over the prior art, the terms and phrase used in the claims must be read in light of the specification. This is necessary to establish whether the meaning of those terms and phrases given by the Applicant in the context of the application should be accorded any meaning different from the usual and customary meaning to the claim terms. Here, Applicant has not sufficiently disclosed the structure of the term "knob" or the phrase "adjusting knob" in his specification. The term "knob" in Merriam-Webster's Collegiate Dictionary tenth edition is defined as "a rounded protuberance". Thus it is considered that Lee discloses an adjusting knob being disposed on the hinge to adjust the angle of the hinge. The spherical ball element of hinge 38 is considered as an adjusting knob since it is a "rounded protuberance" and it is noted that one can hold and rotate this ball element to adjust the angle of the light mechanism.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4** are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper (US Patent No. 6,764,194).

**With respect to claims 1 - 3**, Cooper discloses an apparatus (10) comprising:

- A housing (10) that is adapted for attachment to the brim of a hat (see Fig. 4);
- A light source (15);
- An angular adjustment member (20a);
- A clip (11); and
- Wherein the angular adjustment member comprises a hinge (35).

With respect to the recitation that the device is to be used as a training aid for a golfer and the light to be directed toward a golf ball, as stated in claim 1, it is noted that with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Thus, since the device of Cooper is capable of being used as a training aid for a golfer, the device clearly meets all the limitations of the above claims.

**With respect to claim 4**, Cooper discloses an adjusting knob. Column 6, lines 4-6 state that an adjustable pivot bolt is present in connection 35. As shown in Fig. 4, this bolt that is shown as item 35 is considered as an adjusting knob and it is being disposed on the hinge to adjust the angle of the hinge (see column 6, lines 4-6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Brown et al. (US Patent No. 6,431,732).

**With respect to claim 5**, Cooper fails to disclose a collimated light source. However providing collimated light source is not new and Brown is one reference among many that teaches the use of collimated light source (see column 11, lines 7-8). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Cooper device with collimated light source as taught by Brown in order to provide an eye-safe product as stated in column 11, line 8 of the Brown reference.

**With respect to claim 6**, Cooper fails to teach a collimated light source generating a red light beam. Brown teaches the use of red light beam (see column 12 lines 47-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Cooper device with a light source that generates red laser beam as taught by Brown because a red laser beam is preferred from the viewpoint of performance of drawing the attention of a user.

**With respect to claims 7 and 8**, Cooper discloses a power source (16) and a switch (41).



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**With respect to claim 9**, Cooper discloses a housing that is partly cylindrically shaped (see Fig. 1). The end of the cylindrical section away from the cap element as shown in Fig. 2 is considered a first end the other end or the cylinder is considered the second opposing end.

**With respect to claim 10**, Cooper discloses a housing that is partly cylindrical and partly multisided. However it should be noted that the clip (11) is positioned at the middle of the housing for the light (see Fig. 1). Thus, what Cooper fails to disclose is the housing for the lighting element to be entirely cylindrical. Brown teaches the use of a cylindrical housing (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the housing of the Cooper device out of one uniform cylindrical shape for easiness in manufacturing and lowering manufacturing cost of the device.

**Claims 5-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Sekine et al. (US Patent No. 6,022,126).

**With respect to claim 5**, Lee discloses a laser diode module 14 but he does not explicitly state if the light source comprises a collimated light source. However providing collimated light source is not new and Sekine is one reference among many that teaches the use of collimated light source (see column 4, lines 6-13). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Lee device with collimated light source as taught by Sekine in order to

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provide a device that easily project a laser beam to an intended portion in a stable manner as stated in column 1, lines 54-55 of the Sekine's reference.

**With respect to claim 6**, Lee fails to teach wherein the collimated light source generates a red light beam. Sekine teaches the use of red light beam (see column 3 lines 60-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Lee device with a light source that generates red laser beam as taught by Sekine because a red laser beam is preferred from the viewpoint of performance of drawing the attention of the user, easiness in manufacturing, and manufacturing cost as stated in Sekine's reference (see last paragraph of column 3 and beginning of column 4).

**With respect to claims 7 and 8**, Lee discloses a power source (see column 1, lines 43-44. It is stated that the laser diode is a battery powered laser emitter) and the "button" writing as shown on item 14 for example as shown on Figs. 2 and 13 appears to be the on/off switch. However since Lee does not explicitly state that the button is a switch. Thus, the Sekine's reference can be used to teach that the use of a switch (17) in lighting mechanisms is well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Lee device with a switch as taught by Sekine in order to turn the light on when in use and turn the light off when the device is not in use.

**With respect to claim 9**, Lee fails to disclose a housing that is cylindrically shaped. Sekine discloses a cylindrically shaped housing with first and second opposing ends, wherein the light source is disposed in the first end of the housing (see Fig.1). It would

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have been an obvious matter of design choice to make the different portions of the housing of Lee to be cylindrical as taught by Sekine or of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Applicant has not disclosed if the cylindrically shaped housing provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the rectangular shaped housing as taught by Lee or the cylindrically shaped housing as taught by Sekine because both housings perform the same function of containing the lighting mechanism.

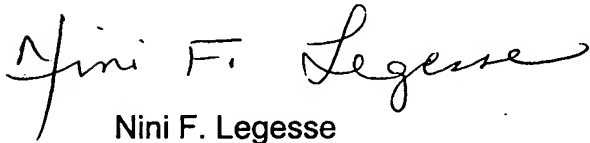
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Nini F. Legesse". The signature is written in black ink and is positioned above the printed name.

Nini F. Legesse

09/24/04